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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,787	10/20/2003	Kenneth Radigan	10251-007	7576

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,787

Applicant(s)

RADIGAN, KENNETH

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☒ Claim(s) 11-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/20/03, 1/7/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1-10, drawn to a method of providing an insurance policy for the decommissioning of a nuclear power facility, classified in class 705, subclass 4.
 - II. Claims 11-19 and 29-37, drawn to an insurance policy product for insuring decommissioning of a nuclear power facility class 705, subclass 4.
 - III. Claims 20-28, drawn to a method of determining a premium for an insurance policy for decommissioning of a nuclear power facility, classified in class 705, subclass 4
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method for providing a nuclear decommissioning insurance policy, while invention II is directed to an insurance policy per se for decommissioning a nuclear power facility. Furthermore, invention III has separate utility such as series of steps for determining a premium of an insurance policy for decommissioning a nuclear power facility. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and/or because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Tzvi Hirshaut on 8/16/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-37 are withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

10. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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11. In the present case, claim 1 only recites an abstract idea. The recited steps of merely supplying an insurance policy, receiving a premium, and paying decommission expenses do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute a particular idea of how to apply and execute an insurance policy for decommission expenses. Moreover, claims 2-10 fail to remedy the deficiencies of claim 1.

12. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-10 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 4 recites the limitation "the decommission" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. While "decommissioning a nuclear power facility" is previously recited in claim 1, there is no previous recitation of "a decommission." However, this rejection could be overcome by replacing "the decommission" with "said decommissioning."

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland, **Risk mitigation in the atomic age** (paragraphs numbered by Examiner, cited in the IDS filed 10/20/03).

18. As per claim 1, Kurland discloses a method for providing financial assurance for decommissioning a nuclear power facility via an insurance policy, the method comprising the steps of: supplying, by an insurer, the insurance policy to a trust, said insurance policy includes a predetermined monetary premium payable to said insurer (see paragraph 31); receiving said premium by said insurer from said trust (see paragraph 32); and paying by said insurer, in accordance with terms of said insurance policy actual decommission expenses to said trust between a policy inception date and a policy termination date to provide financial assurance for decommissioning said facility (see paragraph 34).

19. As per claim 2, Kurland discloses the method of claim 1 as described above. Kurland further discloses the step of investing, by said insurer, the received premium in a financial instrument (see paragraph 32, note that portions of premiums can be refunded based on loss experience over a given period).

20. As per claim 3, Kurland discloses the method of claim 2 as described above. Kurland further discloses said step of paying actual decommission expenses pays said trust using proceeds at least in part from the invested premium (see paragraph 33).

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21. As per claim 5, Kurland discloses the method of claim 1 as described above. Kurland further discloses said step of paying pays said actual decommission expenses to said trust between the policy inception and termination dates, based on a predetermined time schedule, wherein said predetermined time schedule includes a plurality of stages (see paragraph 34).

22. As per claim 7, Kurland discloses the method of claim 1 as described above. Kurland further discloses said policy is an existing insurance policy between said policy inception and termination dates (see paragraph 34).

23. As per claim 8, Kurland discloses the method of claim 1 as described above. Kurland further discloses said trust is one of a qualified or non-qualified trust (see paragraph 32, to the best of the Examiner's understanding, the trust must be considered either a qualified or a non-qualified trust).

24. As per claim 9, Kurland discloses the method of claim 1 as described above. Kurland further discloses the step of paying in accordance with said terms of said insurance policy, unexpected decommissioning expenses (see paragraph 34).

25. As per claim 10, Kurland discloses the method of claim 1 as described above, Kurland further discloses said premium is received in one of a onetime payment or a series of periodic payments (see paragraph 32, note that annual premium amounts are disclosed).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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27. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland, **Risk mitigation in the atomic age** in view of Cepkauskas, U.S. Patent No. 5,297,182.

28. As per claim 6, Kurland discloses the method of claim 5 as described above. Kurland does not explicitly disclose the first, second, and third stages recited in the claim. Cepkauskas teaches a method for decommissioning a nuclear facility that includes a first stage of removing spent fuel and disconnecting operating systems from said facility (see column 5, lines 21-30); a second stage of dismantling all equipment and buildings for said facility (see column 5, lines 21-30); and a third stage of removing all materials with radioactivity levels above a predetermined limit (see column 5, line 57 – column 6, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this method for the decommissioning of the nuclear facility within the method disclosed by Kurland. One of ordinary skill in the art would have been motivated to employ this method for the purpose of reducing total disposal cost (see column 6, lines 3-6) which would be of benefit to both the insurance providers as well as the insured described in Kurland.

Allowable Subject Matter

29. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

30. The following is a statement of reasons for the indication of allowable subject matter: The primary reason for the distinction of claim 4 over the closest prior art is the inclusion of the limitations, in the claim which are found in the prior art references, of determining a premium of an insurance policy for decommissioning a nuclear power facility by the particular recited steps of determining a total monetary sum for a plurality of scenarios that are each based on the

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decommissioning starting on a different time schedule, and adjusting the monetary sum of each scenario so that they are each substantially equal. While the closest prior art (Kurland, **Risk Mitigation in the Atomic Age**) discusses several insurance providers that provide nuclear decommissioning coverage (see paragraph 31 as numbered by Examiner), it fails to disclose any particular method for determining a premium for such a policy. In addition, the article discloses estimating a cost for nuclear decommissioning that takes place on a particular date (see paragraph 26). However, there is no indication that this would be used to determine a premium for an insurance policy.

31. Additionally, Fox, U.S. Patent No. 4,766,539, cited in the IDS filed 10/20/03, teaches a method for determining a premium for an insurance policy against specified weather conditions (see column 2, lines 30-55). While this premium is determined based on predetermined time intervals in each of a predetermined number of years (see column 2, lines 30-36), this is only used to determine probabilities of weather conditions actually occurring. Whereas the time schedules recited in claim 20 are utilized to determine expenses that are inevitable to occur due to Nuclear Regulatory Commission requirements (see page 2, lines 7-13 of the Specification). Therefore, the claims distinguish over the teachings of Fox as well.

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

08/19/05



C. Luke Gilligan
Patent Examiner
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